

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 14

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte FRANK S. GLAUG and MARGARET A. KATO

Appeal No. 1998-0243
Application 08/455,374

ON BRIEF

Before CALVERT, FRANKFORT and BAHR, Administrative Patent Judges.

CALVERT, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1 to 25, all the claims in the application.

The claims on appeal are drawn to a process for making disposable absorbent articles, disclosed as being training pants for children. Claims 1 to 25 are reproduced in the appendix of appellants' brief.

The references applied in the final rejection are:

Magid	3,225,764	Dec. 28, 1965
Nomura et al (Nomura)	5,147,487	Sep. 15, 1992

The claims stand finally rejected on two grounds:

- (1) Claim 1 to 25, unpatentable over Nomura in view of Magid, under 35 U.S.C. § 103.
- (2) Claims 12 to 25, provisionally rejected on the ground of obviousness-type double patenting over claims 1 to 22 of copending application No. 08/456,239.¹

Rejection (1)

On page 3 of their brief, under “Grouping of the Claims,” appellants state that “claims 1-11 stand together, and claims 12-25 stand together.” However, since appellants do not explain why claims 12 to 25 are believed to be separately patentable from claims 1 to 11, claims 1 to 25 will be treated as a single group, and pursuant to 37 CFR 1.192 (c)(7), we select claim 1 from the group and will decide rejection (1) on the basis of that claim.

We note in passing that on page 2 of the brief, lines 2 and 3, appellants indicate that claim 12 is drawn to the method illustrated in Figures 5 and 6. This does not appear to be correct because claim 12, like claim 1, recites the step of “folding each edge portion [of the base layer], generally in a cross direction, over the elastic member.” Such a step is a part of the method shown in Figure 4, as disclosed at page 50, lines 8 to 14. On the other hand, in the method of

¹ Since the ‘239 application issued as Patent No. 5,711,832 on Jan. 27, 1998, the rejection is no longer provisional.

Figures. 5 and 6, the edge portions 102, 104 of the base layer 98 are not folded over the elastic member 88 (contained in composites 97 and 112), but instead the composites are attached to the edge portions of the base layer by adhesive 74 (page 44, lines 19 to 24).

Turning to the merits of the rejection, the examiner describes on pages 3 and 4 of the answer the portions of the disclosures of Nomura and Magid which are relevant to the method recited in claim 1; in particular, we note that Nomura discloses at col. 7, lines 19 to 22, that the adhesive 32, to which the waist elastic members 4 are bonded, may be applied “in a plurality of dots, intermittent lines or helical lines.” As for the combination of Nomura and Magid, the examiner asserts that (answer, pages 4 to 5):

It would have been obvious to one having ordinary skill in the art to have folded the waistband, as is known from Magid, in the method of Nomura in order to provide better integrity and strength at the waistband because both references are directed to the construction of training pants. It is the examiner’s position that in the above combination, it would have been obvious to one having ordinary skill in the art to fold the waistband after application of the elastic material but before the step of folding along the central line 34.

Appellants contend that the combination would not have been obvious because the references do not recognize the problems discovered and solved by appellants, and there is no suggestion or compelling motivation to produce the claimed invention (brief, page 7).

We do not agree with appellants’ argument. The case of In re Wright, 848 F.2d 1216, 1219, 6 USPQ2d 1959, 1961 (Fed. Cir. 1988), cited by appellants at page 7 of their brief, has been overruled to the extent that it held that a prima facie obviousness rejection is not supported if no reference shows or suggests the newly-discovered properties and results of a claimed

invention. In re Dillon, 919 F.2d 688, 693, 16 USPQ2d 1879, 1901 (Fed. Cir. 1990), cert. denied, 500 U.S. 904 (1991). Rather, as stated in In re Beattie, 974 F.2d 1309, 1312, 24 USPQ2d 1040, 1042 (Fed. Cir. 1992), “As long as some motivation or suggestion to combine the references is provided by the prior art taken as a whole, the law does not require that the references be combined for the reasons contemplated by the inventor.” See also In re Kemps, 97 F.3d 1427, 1430, 40 USPQ2d 1309, 1311 (Fed. Cir. 1996). In the present case, folding the material at the waist of a pair of training pants over the waist elastic to form a hem, as disclosed by Magid in Figure. 2 and at col. 2, lines 42 to 52, would provide the self-evident advantage of a hem, namely, as stated by the examiner, supra, “better integrity and strength at the waistband.” We therefore conclude that Magid would have suggested to one of ordinary skill folding the edges of the Nomura web 26 over the waist elastic members 4, as recited in the sixth step of claim 1, in order to achieve the benefits of such an arrangement.

There still remains the question of whether the combination of Nomura and Magid would have rendered obvious the final (ninth) step of claim 1, which reads:

forming a plurality of disposable absorbent articles having a respective plurality of closed-loop waist-elastic systems in which each waist elastic system has an average maximum magnitude of decay of less than about 66.67 grams in an extension range of about 175 millimeters to about 300 millimeters over the first three cycles.

As we understand appellants' disclosure, a reduction in decay² in the waist elastic system is achieved by reducing the area, or number of points, at which the waist elastic member is joined to the surrounding or adjacent layer of material. As disclosed by appellants at page 9, lines 1 to 8:

The present invention selectively reduces the joined surface area, or the number of points of joinder, between an elastic member and its respective layer to which it is joined. For example, the elastic member may not be attached along its full length to the layer. The present invention provides a plurality of selectively spaced apart, distinct adhesive zones. By reducing the surface area of joinder between the elastic member and the layer of material, there is a resultant reduction in the elastic member's loss of elasticity.

Since Nomura discloses that the adhesive 32 for the waist elastic 4 may be applied in "intermittent lines" (col. 7, lines 19 to 22), the elastic members 4 of Nomura would be joined to the web at spaced apart points and therefore, according to appellants' above-quoted disclosure, this reduction in the surface area of joinder would inherently cause a reduction in the loss of elasticity (decay) of the Nomura elastic members.

With regard to the specific figures recited in the last step of claim 1, the examiner states (answer, page 5):

lacking any criticality in the specification, the use of materials having properties in the claimed ranges solves no stated problem and would have been an obvious matter of design choice within the skill in the art.

We do not agree with the examiner insofar as he may indicate that appellants' invention "solves

² "Decay" is defined at page 6, lines 8 and 9 of the specification as "a loss of tension at a specific extension over a selected number of cycles."

no stated problem.” In particular, as to claim 1, appellants disclose that the reduction in loss of elasticity (decay) solves a problem, in that they state at page 40, lines 9 to 12, that it is “[a]nother important factor in providing a substantially uniform low tension over a wide size range, a more comfortable fit, and improved ease of use.”

However, this does not resolve the issue because it is well settled that:

The law is replete with cases in which the difference between the claimed invention and the prior art is some range or other variable within the claims. See, e.g., Gardner v. TEC Sys., Inc., 725 F.2d 1338, 220 USPQ 777 (Fed. Cir.), cert. denied, 469 U.S. 830 (1984); In re Boesch, 617 F.2d 272, 205 USPQ 215 (CCPA 1980); In re Ornitz, 351 F.2d 1013, 147 USPQ 283 (CCPA 1965); In re Aller, 220 F.2d 454, 105 USPQ 233 (CCPA 1955). These cases have consistently held that in such a situation, the applicant must show that the particular range is critical, generally by showing that the claimed range achieves unexpected results relative to the prior art range. Gardner, 725 F.2d at 1349, 220 USPQ at 786 (obviousness determination affirmed because dimensional limitations in claims did not specify a device which performed and operated differently from the prior art); Boesch, 617 F.2d at 276, 205 USPQ at 219; Ornitz, 351 F.2d at 1016-17, 147 USPQ at 286; Aller, 220 F.2d at 456, 105 USPQ at 235.

In re Woodruff, 919 F.2d 1575, 1577-78, 16 USPQ2d 1934, 1936-37 (Fed. Cir. 1990). See also In re Geisler, 116 F.3d 1465, 1469-70, 43 USPQ2d 1362, 1365 (Fed. Cir. 1997). Here, the upper decay limit of about 66.67 grams, recited in claim 1, is the higher of the average decay for appellants’ Embodiments 1 and 2 (Table 13, page 30). Table 13 shows that this figure is lower than the average decay for Samples 1 to 7, but although appellants identify these Samples at pages 15 and 16 as being various commercially available training pants, they do not disclose how their waist elastic systems are constructed, so that it cannot be determined whether any of the Samples have an elastic member joined to another layer at less than its full length, and if so, what

the joined surface area is in comparison to appellants' Embodiments 1 and 2.

In any event, the use of intermittent lines of adhesive as disclosed by Nomura would, as discussed above, inherently cause a reduction in the decay of the waist elastic members 4. Accordingly, we consider that the examiner has made out a prima facie case of obviousness as to claim 1. Although Nomura appears on this record to be the closest prior art, appellants have not presented any evidence to rebut the prima facie case of obviousness by showing that the claimed decay range of less than about 66.67 grams is critical relative to the general reduction in decay which would result from following the teaching of Nomura.

The rejection of claim 1 under U.S.C. § 103 will therefore be sustained, as will the rejection of claims 2 to 25, grouped therewith.

Rejection (2)

Appellants have presented no arguments in their brief concerning this rejection. Consequently, it will be summarily sustained.

Conclusion

The examiner's decision to reject claims 1 to 25 under 35 U.S.C. § 103, and to reject claims 12 to 25 on the ground of obviousness-type double patenting, is affirmed.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

IAN A. CALVERT)	
Administrative Patent Judge)	
)	
)	
)	BOARD OF PATENT
CHARLES E. FRANKFORT)	
Administrative Patent Judge)	APPEALS AND
)	
)	INTERFERENCES
)	
JENNIFER D. BAHR)	
Administrative Patent Judge)	

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